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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/524,031 | 02/09/2005 | Katsuhiro Minami | 0033-0980PUS1 | 4881 |

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| EXAMINER | |
|---|---|
| GREEN, ANTHONY J | |
| ART UNIT | PAPER NUMBER |
| 1755 | |

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/524,031 | MINAMI, KATSUHIRO | |
| | Examiner | Art Unit | |
| | Anthony J. Green | 1755 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02/09/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/103*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Karton et al (US patent No. 5,531,930).

The reference teaches, in the "Detailed Description of the Invention" section namely lines30-50, the production of aluminum flake having lateral face dimensions (i.e. length, diameter, width or the like) in the range of about 1.5 to about 20 microns and having a thickness in the range of about 0.03 to 0.27 micron. The aluminum flake is generally manufactured by milling together atomized aluminum powder with mineral spirit and coating additive.

The instant claims are met by the reference as the reference teaches an aluminum flake that encompasses that which is instantly claimed. The mineral spirit is

seen to meet the organic solvent and the milling step is seen to meet the grinding step absent evidence to the contrary.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Souma et al (US Patent No. 5,213,618).

The reference teaches, in column 3, metal flakes which may include aluminum having an average particle diameter or 1 to 100 microns and a thickness from 0.01 to 20 microns.

The instant claims are met by the reference. While the reference is silent as to how the flakes are formed it is the position of the examiner that the resulting flakes are the same. As stated in MPEP 2113 [R-1] "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to

be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

5. Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Specification No. 10-176120.

The reference teaches, the use of an aluminum flake having an average thickness of 0.05 -2.0 micron and an average diameter of 5-55 microns in a primer paint composition.

The instant claims are met by the reference. While the reference is silent as to how the flakes are formed it is the position of the examiner that the resulting flakes are the same. As stated in MPEP 2113 [R-1] "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional

fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). As for the makeup of the paint, it is known in the art that paint compositions are made up of binders and solvents.

6. Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Specification No. 2000-136329.

The reference teaches, the use of an aluminum flake having an average thickness of 0.01-0.1 micron and an average diameter of 1-60 microns in a paint composition.

The instant claims are met by the reference. While the reference is silent as to how the flakes are formed it is the position of the examiner that the resulting flakes are the same. As stated in MPEP 2113 [R-1] "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964,

966 (Fed. Cir. 1985) (citations omitted). "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). As for the makeup of the paint, it is known in the art that paint compositions are made up of binders and solvents.

7. Claims 1-3, 5 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Specification No. 2001-29877.

The reference teaches, in the abstract, a flake-like aluminum pigment wherein particles of the aluminum have a thickness of 0.01-0.2 micron and an aspect ratio of 100-300. The particle diameter, found from these values, includes the range 8 to 30 microns.

The instant claims are met by the reference. While the reference is silent as to how the flakes are formed it is the position of the examiner that the resulting flakes are the same. As stated in MPEP 2113 [R-1] "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the

product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). As for the makeup of the paint, it is known in the art that paint compositions are made up of binders and solvents.

8. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Souma et al (US Patent No. 5,213,618).

The reference was discussed previously and further the reference teaches the use of metal flake pigments in coating compositions, ink compositions etc.

The instant claims are obvious over the reference. While the reference does not specifically recite an example wherein an aluminum flake pigment having the recited properties is used in paints or ink compositions it does suggest that it may be used

therein and accordingly claims 3-8 are obvious. Note that the reference teaches the use of various solvents and film forming resins to form the coating and ink compositions.

9. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karton et al (US patent No. 5,531,930) as applied to claims 1-2 above, and further in view of Souma et al (US Patent No. 5,213,618)

Both references were discussed previously.

The instant claims are obvious over the combination of references. While the primary reference does not recite the use of the aluminum flakes in paint compositions or ink compositions, the secondary reference teaches that it is well known in the art to utilize metal flakes in coating compositions and ink compositions, thus it would have been obvious to utilize the composition of the primary reference in a paint or an ink compositions absent evidence showing otherwise.

### *Information Disclosure Statement*

10. The references were considered by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
February 1, 2006